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EXAMINER

ROCHE, LEANNA M

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 31

Application Number: 09/390,583
Filing Date: September 02, 1999
Appellant(s): ANDERSEN ET AL.

MAILED

SEP 27 2002

GROUP 1700

John M. Guynn
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 26, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that

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there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Issue 1, as summarized by Applicant, is the only issue in the present case. Issue 1, as summarized by Applicant, encompasses Issues 2 and 3.

(7) Grouping of Claims

The rejection of claims 32-57 stands or falls together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 32-57 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based.

As stated in *Ball Corp. V. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

The newly amended claims do not contain the limitation that the fibrous material has an average fiber length of greater than about 2 mm. The newly amended claims contain the limitation that the fibrous material has a fiber length less than about 25 mm. Therefore, the newly amended claims read on something that the original claims do not. Specifically, the newly amended claims read on materials, which contain a fibrous material, having an average fiber length of less than about 2 mm.

It is noted that the limitation that the fibrous material has an average fiber length of greater than about 2 mm was relied upon by the applicants in the original prosecution to distinguish over Tiefenbacher et al. See page 11, first full paragraph to page 13, line 3 of Paper No. 7 dated March 18, 1996 in U.S. Serial No. 08/327524, where it is argued that "[e]ach of independent claims 1, 23, 30 and 49 was originally drafted to include the limitation that the 'fibers hav[e] an average fiber length greater than about 2 mm'. In contrast, *Tiefenbacher et al.* teaches away from the use of fibers larger than 1.5 mm, as discussed hereinbelow. The ability to successfully mold a starch-bound article having fibers that have 'an average fiber length greater than about 2 mm' is made possible by

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the inclusion of pregelatinized starch component in significant quantities within the starch-based composition during the mixing process...This results in much more effective dispersion of the fibers, particularly 'fibers having an average fiber length greater than about 2 mm...[F]ibers having an average fiber length greater than about 2 mm' are an important component because they provide an important reinforcing function within the molded starch-bound articles...it is clear that *Tiefenbacher et al.* fails to teach or suggest the tremendous strengthening effect of the fibers, particularly well-dispersed fibers having an average length greater than about 2 mm."

(11) Response to Argument

In an attempt to be fully responsive and to simplify the arguments presented by Applicant, the examiner has determined that there are three main points of contention in the present case. 1) Applicant contends that the examiner has ignored the teachings of *Hester Industries, Inc. v. Stein, Inc.*, 46 USPQ2d 1641 (Fed. Cir. 1998) and *Ball Corporation v. United States*, 221 USPQ 289 (Fed. Cir. 1984) by failing to apply the "exception to recapture rule." 2) Applicant argues that the examiner has repeatedly focused on a single limitation when determining the existence of recapture, rather than evaluating the overall scope of the claim. 3) Applicant argues that the examiner has repeatedly failed to consider whether the materially narrowing claim limitations avoid recapture.

With regard to the application of pertinent case law, the examiner relied upon the two-part test set forth in the MPEP 1412.02, because the MPEP "contains instructions to examiners, as well as other material in the nature of information and interpretation,

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and outlines the current procedures which the examiners are required and authorized to follow in appropriate cases in the normal examination of a patent application.” The MPEP was established as a guide which was created based on various binding decisions by the court. Evidence of this is found in the fact that the examiner relied on the Two-Step Test for Recapture set forth in MPEP 1412.02 which is based on *Clement*, (131 F.3d at 1468-69, 45 USPQ 2d at 1164), wherein the Court of Appeals for the Federal Circuit set forth guidance for recapture. Additionally, it is noted that the teachings of *Hester* incorporate the teachings set forth in *Clement* which incorporate the teachings set forth in *Ball*. Thus, it is the position of the examiner that the rules set forth by the Federal Circuit have in no way been disregarded during examination.

With regard to the argument that the examiner focused solely on a single limitation rather than the overall scope of the claims when testing for recapture, the MPEP 1412.03 states that “a broadened reissue claim is a claim which enlarges the scope of the claims of the patent...A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in *at least one* respect, even though it may be narrower in other respects.”

It has been the position of the Examiner that newly amended claims 32-57 broaden the scope of the claims of the patent because the patent contained the limitation that the fibrous material has an average fiber length of greater than about 2 mm. The newly amended claims contain the limitation that the fibrous material has a fiber length less than about 25 mm. Therefore, the newly amended claims read on something that the original claims do not. Specifically, the newly amended claims read

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on materials, which contain a fibrous material, having an average fiber length of less than about 2 mm. Thus, the overall scope of the claim has been “enlarged”.

With regard to the argument that the examiner ignored materially narrowing claim limitations, Applicant cites *Hester* to show that the recapture rule may be avoided in some circumstances where claims were materially narrowed in other respects. *Hester* specifically cites *In re Clement*, 45 USPQ2d 1161, to show that “reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule.” However, *Clement* also states that “the recapture rule does not apply when the broadening not only relates to an aspect of the claim that was never narrowed to overcome prior art, or argued as distinguishing the claim from the prior art, but also is not materially related to the alleged error.” Therefore, because the various claim limitations are not related to the subject matter surrendered in the original application, specifically those fibers having an average length less than about 2 mm, and they are not related to the manner in which it defined over the art, recapture exists.

Also, it is set forth in Pannu that there can still be recapture even if the reissue claims are narrower in other respects. In Pannu, it was argued that because the reissued claims were materially narrowed in other respects, the reissue avoids the recapture rule. The fact scenario in Pannu, like the present case, involved a situation where the narrower aspects dealt with limitations unrelated to the limitation being surrendered. Specifically, in Pannu, the narrower limitations dealt with the positioning and dimensions of the snag resistant means, not the shape of the haptics. The court, in Pannu, held that the narrowing aspect of the claim on reissue was not related to the

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shape of the haptics, but rather the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening. Furthermore, "if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and stops its recapture." *Anderson Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634 (Fed. Cir. 1998); see also *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525 ("[I]n this case, the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Mentor thus attempted to reclaim what it earlier gave up."). In prosecuting the original patent, Pannu specifically limited the shape of the haptics to a "continuous, substantially circular arc." On reissue, he is stopped from attempting to recapture the precise limitation he added to overcome prior art rejections. In the present case, it is the examiner's position that the omission of limitation that the fibrous material has an average fiber length of greater than about 2 mm is improper recapture when using either the two-part test detailed in the MPEP (1412.02) or the three-part test set forth in Pannu. In the present case, the narrowing aspects do not deal with the fibrous material, but rather the coating material and process of forming the composite composition. Thus, the present claims are not narrowed in any material aspect compared with the broadening. Following the binding and clear holdings by the Federal Circuit in Pannu, the applicants in the present case are stopped from attempting to recapture the limitation they argued to overcome the prior art rejections in the original prosecution.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Imr

September 23, 2002

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